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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,692

11/26/2003

James B. McCormick

46521-56177

8923

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7590

02/27/2009

THOMPSON COBURN LLP

ONE US BANK PLAZA

SUITE 3500

ST LOUIS, MO 63101

EXAMINER

JARRETT, LORE RAMILLANO

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

02/27/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPDOCKET@THOMPSONCOBURN.COM

Office Action Summary

Application No.

10/723,692

Examiner

LORE RAMILLANO

Applicant(s)

MCCORMICK, JAMES B.

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2009.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/26/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-949)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

In view of the Pre-Appeal Conference Request filed on 1/20/09, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

Response to Amendment

Status of Claims

2. Applicant's reply filed on 1/20/09 is acknowledged. Claims 1-7 are pending and are under examination.

Prior art rejections

3. The rejection by Hartl in light of Roe is withdrawn. The remaining rejections are maintained. A new rejection follows.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hartl ("Hartl," US 4225557) in light of Roe et al. ("Roe," US 6060039).

In figures 1-3, Hartl discloses a foldable liquid permeable sheet (i.e. cardboard) having edges; a liquid permeable target (i.e. 13) disposed on the foldable liquid permeable sheet within the edges of the sheet, thereby providing extended flap portions

which flap portions are foldable to overlap the liquid permeable target; and a malleable securing strip (i.e. 18) attached to the foldable liquid permeable sheet of a length sufficient to secure the folded flap portions overlapping the liquid permeable target (i.e. column 3, lines 30-47).

Hartl further discloses, in figures 1-3, the following: that the malleable securing strip is attached at an edge of the liquid permeable sheet; the liquid permeable target is coated with a release agent (i.e. col. 3, lined 46- 47); the permeable target is a permeable paper sheet (i.e. col. 3, lines 46-47).

Roe discloses a floor (11) of a container (10) in fig. 7B, that may be made of a material that is permeable to water, such as cardboard, nitrocellulose or paper in, i.e. col. 11, line 63 to col. 12, line 2. Hartl's cardboard sheet is inherently liquid permeable because Roe discloses that cardboard is a material that is permeable to water.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartl, in light of Roe, and in view of Rochette (US 3537636).

The disclosure of Hartl, in light of Roe, is stated above. Hartl, in light of Roe, does not specifically disclose having a malleable securing strip comprising a metal wire or a metal foil.

In figures 1-4, Rochette discloses an invention consisting of a reclosable bag formed from a sheet of flexible material. The bag further comprises a bendable metal

wire and a pair of flexible coverings strips (i.e. metal foil), which are sealed together and the wire is sandwiched between so that the wire is embedded between the strips (i.e. column 2, line 70 to column 3, line 8). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the malleable securing strip of Hartl, in light of Roe, with a metal wire and/or with a metal foil because it would be beneficial to have a sealing means that provides reinforcement.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartl, in light of Roe, and in view of Lee (US 6372514).

The disclosure of Hartl, in light of Roe, is indicated above.

Lee discloses an analytical test device for analyzing biological fluids, for example, urine. The device has a top with one or more display ports, and optionally, a sample aperture, an entry port and a vertical bar. The device also has a bottom with an upper plane, a slope and a contacting surface attached to the slope at a descending angle, optionally, a lower plane between the slope and contacting surface and, optionally, an entry port. The device further has a strip made up of an absorbent membrane, a reaction membrane with one or more reagents that form a reaction complex with an analyte in a fluid sample and, optionally, a collecting pad. (i.e. col. 3, lines 19-25).

Lee further discloses that the reaction membrane will preferably be a chromatographic strip coated with gelatin to enhance the life of the strip and clarity of any visible reactions produced in the test. (i.e. col. 10, lines 29-58).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Hartl, in light of Roe, by incorporating gelatin to the liquid permeable target of Hartl, in light of Roe, because enhance the life of the device and clarity of any visible reactions produced in the test (i.e. Lee, col. 10, lines 29-58).

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartl, in light of Roe.

The disclosure of Hartl, in light of Roe, is indicated above. While Hartl, in light of Roe, discloses having an X and Y coordinate marking lines on the liquid permeable target in fig. 1 for explanatory purposes, Hartl, in light of Roe, does not specifically disclose having such marking lines physically on the liquid permeable target. It would have been obvious to a person of ordinary skill in the art to modify Hartl, in light of Roe, by physically having the X and Y coordinate marking lines on the liquid permeable target because it would be allow the user to quickly determine whether the sample is placed on the portions of the target that has the greatest color intensity to insure a correct diagnosis is made.

Response to Arguments

10. Applicant's arguments, see p. 2, filed 1/20/09, with respect to the rejection of claim 5 under Hartl in light of Roe has been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground of rejection is made in view of Hartl, in light of Roe, and in view of Lee.

11. Applicant's arguments filed 1/20/09, with regard to claims 1-4 and 6-7, have been fully considered but they are not persuasive.

35 USC 102(b) rejection by Hartl in light of Roe

In response to applicant's argument that Hartl teaches away from Applicant's invention, as claimed, and would also destroy Applicant's Invention, as claimed, for its stated purpose of providing a foldable liquid permeable sheet having extended flap portions which flap portions are foldable to overlap the liquid permeable target, where the liquid is histological examination liquid, examiner respectfully does not find this argument to be persuasive. Arguments that the alleged anticipatory prior art is 'nonanalogous art' or 'teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, are not germane' to a rejection under section 102. Furthermore, the argument of destroying the Applicant's invention is also not germane to a rejection under section 102 (see MPEP 2143.01). Here, the basis of the Hartl rejection, with regard to claims 1-2 and 6, is under 35 USC 102(b).

In response to applicant's argument that "cardboard" is not inherently permeable, examiner respectfully disagrees. Note that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation. Therefore, Roe properly shows an inherent characteristic of Hartl's liquid permeable cardboard. Furthermore, applicant by his own admission, in the reply filed on 1/20/09, p. 1, agrees that cardboard is permeable.

In response to applicant's argument that Hartl does not disclose a malleable securing strip because the alleged definition of "malleable securing strip" requires material that clearly precludes the use of a slit, examiner respectfully disagrees. A

claim must be interpreted in light of the specification without reading limitations into the claim. In applicant's original filed disclosure, the claim language, "malleable securing strip," does not appear to be limited by a definition in the original disclosure since the originally filed disclosure does not appear to clearly set forth the definition of such language explicitly and with reasonable clarity, deliberateness, and precision. Here, Hartl's strip (i.e. 18, fig. 1) is inherently malleable since it can bend to allow the tabs to be inserted into the strip. Also, Hartl's strip is inherently a securing strip because it fastens the tab to the sheet.

In response to applicant's argument that the slits (18 and 18') disclosed by Hartl are not located at the edge of sheet, examiner respectfully disagrees. Based on the drawings disclosed by Hartl (i.e. figs. 1-2), it appears that the slits are located at the edge of the sheet.

35 USC 103(a) rejection over Hartl, in light of Roe, and in view of Rochette

In response to applicant's argument that there is no teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention, examiner respectfully disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

examiner has properly shown that one of ordinary skill in the art would be motivated to combine the prior art references because it would be beneficial to have a sealing means with a metal wire and/or with a metal foil to provide reinforcement.

In response to applicant's argument that the X and Y coordinate markings are wholly absent from both Hartl and Roe, examiner respectfully does not find this argument to be convincing. Examiner has provided the required motivation, in the previous Office action (filed 5/1/08), to combine the references by indicating that it would have been obvious to a person of ordinary skill in the art to modify Hartl, in light of Roe, by physically having the X and Y coordinate marking lines on the liquid permeable target because it would be allow the user to quickly determine whether the sample is placed on the portions of the target that has the greatest color intensity to insure a correct diagnosis is made. The motivation to combine the prior art references is proper, especially, since Hartl, in light of Roe, discloses having X and Y coordinate marking lines on the liquid permeable target in fig. 1 for explanatory purposes.

Furthermore, it is not necessary that the prior art suggest the modification to achieve the same advantage or result discovered by applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORE RAMILLANO whose telephone number is (571)272-7420. The examiner can normally be reached on Mon. to Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797

Lore Ramillano
Examiner
Art Unit 1797

2/19/09